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Paper No. 5
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JUL 05 2002

OFFICE OF PETITIONS

In re Application of
Mariette Lehto
Application No. 09/903,225
Filed: July 11, 2001
Attorney Docket Number: 2132-48PCON

DECISION REFUSING STATUS
UNDER 37 C.F.R. §1.47(b)

This is in response to the petition under 37 C.F.R. §1.47(b), filed March 27, 2002.

Rule 47 applicant is given **TWO MONTHS** from the mailing date of this decision to reply, correcting the below-noted deficiencies. Any reply should be entitled "Request for Reconsideration of Petition Under 37 C.F.R. §1.47(b)," and should only address the deficiencies noted below, except that the reply may include an oath or declaration executed by the non-signing inventor. **Failure to respond will result in abandonment of the application.** Any extensions of time will be governed by 37 C.F.R. §1.136(a).

The above-identified application was filed on July 11, 2001, without an executed oath or declaration, and naming Mariette Lehto as sole inventor. Accordingly, on August 27, 2001, a Notice to File Missing Parts of Application - Filing Date Granted was mailed, requiring applicant to submit an executed oath or declaration and pay a surcharge for late filing. The Notice set an extendable two month period for reply.

In reply, applicant filed the instant petition (and fee) and paid the surcharge for late filing of the declaration. To make timely, applicant also filed a request for a (5) five-month extension of time (and fee). Accompanying the petition is an extract from the trade register of Sonera Oyi, purported assignee, statement from European patent attorney, Markku Simmelvuori, assignment document, certified letter of employment, affidavit of Anni Vepsäläinen employee of purported assignee, correspondence between foreign counsel and U.S. counsel and, an executed Declaration and power of attorney.

A grantable petition under 37 C.F.R. §1.47(b) requires: (1) proof that the non-signing inventor cannot be reached or refuses to sign the oath or declaration; (2) an acceptable oath or declaration; (3) the petition fee; (4) a statement of last known address of the non-signing inventor; (5) proof of proprietary interest; and (6) a showing that such action is necessary to preserve the rights of parties or to prevent irreparable damage. Rule 47 applicant has failed to establish (1), and (2).

Proof of Refusal to Sign the Oath or Declaration

As to item (1), rule 47 applicant has failed to show that non-signing inventor has refused to execute the application papers. Although the petition and the affidavit of Anni Vepsäläinen indicate the application papers including the declaration were forwarded to inventor Lehto, there is no specificity as to the manner in which the

application papers were mailed to inventor Lehto. Was the application mailed or delivered? Furthermore, the affidavit merely indicates the application was forwarded "in or about July 2001". Did rule 47 applicant follow-up with a phone call? Upon renewed petition, rule 47 applicant may wish to provide more specific facts as to how and when the application papers were provided to inventor Lehto.

An Acceptable Oath or Declaration

As to item (2), although rule 47 applicant submitted the \$130 surcharge fee for the submission of a late oath or declaration, Applicant failed to submit an oath or declaration in compliance with the 37 CFR 1.63 and 1.64. The granting of 47 status requires a rule 47 (b) applicant to make the oath or declaration. An officer of a corporation normally is required to sign the oath or declaration. See MPEP 409.03(b).

The declaration has two signatures one from the general counsel and one from assistant general counsel. However, the names and address on the declaration are barely legible. Furthermore, due to the illegibility of the signatures, the Office is incapable of verifying via the Extract from the Trade Register whether the counselors are authorized to execute a declaration on behalf of Sonera Oyj. If the counselors are not identified on the Extract from the Trade Register as being capable of binding Sonera Oyj, on renewed petition evidence must be supplied of such authority.

Lastly, the declaration needs to include the date it is executed.

Petition Fee

As to item (3), applicant has paid the \$130 petition fee pursuant to 37 CFR 1.17(h).

Statement of Last Known Address

As to item (4), applicant has provided the last known address of the non-signing inventor.

Proof of Proprietary Interest

As to item (5), applicant has established proprietary interest via the statement of European patent attorney Markku Simmelvuori, and the certification of employment relationship.

Showing That Such Action Is Necessary to Preserve the Rights of Parties or to Prevent Irreparable Damage.

As to item (6), applicant has provided a statement that the granting of rule 47 status is necessary to preserve the rights of the party or prevent irreparable damage. See MPEP 409.03(h).

Further correspondence with respect to this matter should be addressed as follows:

By mail: Assistant Commissioner for Patents
Box DAC
Washington, D.C. 20231


By FAX: (703) 308-6916
Attn: Office of Petitions

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By hand: Crystal Plaza Four, Suite 3C23
2201 S. Clark Place
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Telephone inquiries regarding this decision should be directed to Petitions Attorney
Charlema R. Grant at (703) 305-0309.


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